

Atty. Docket No. JP920000032US1
(590.050)

REMARKS

Applicant and the undersigned are most grateful for the time and effort accorded to the instant application by the Examiner. Claims 1-7 were pending in the instant application at the time of the outstanding Office Action dated July 7, 2005. In the Office Action Claims 1-7 were rejected and the rejection made final. Claims 1-7 are all independent claims.

On September 15, 2005, Applicant's counsel conducted a telephone interview with the Examiner in which the present application and the Ahmad reference were discussed. No agreement, however, was reached with respect to the claims of the present application. The Examiner suggested that a Request for Reconsideration reiterating the Applicant's position might prove to be beneficial in advancing the prosecution of the present application. Therefore, the Office is respectfully requested to reconsider the current rejections in the outstanding Office Action in light of the following remarks.

A focused discussion of the rejected claims and the reasons for finding that the presently claimed invention is non-obvious in view of the prior art is addressed below; however, it will be helpful to first broadly summarize one embodiment of the preferred invention, as well as the Ahmad reference, so as to clarify some of the major distinctions between this invention and the prior art. It should be understood that this discussion of the invention is done broadly and is not intended to replace, alter, or limit the invention as set forth in the Applicant's application, including the claims and specification thereof.

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The Present Invention: An Overview

At minimum, three important facets to the present invention should be considered, they are: the problem overcome by the invention; the generation and updating of a License Key (L-key); and the use of a Program Key (P-key) as a means for tracking software and being involved in generating licensing information.

One of the problems overcome by the present invention is the difficulty of an Internet Service Provider (ISP) to provide the use of software to its customers as an enclosure means, i.e., the problem of allowing the use of essentially free software by ISP customers as a way of enticing patronage. One way this problem is overcome is by making an ISP user's authorized membership a condition that must be met to enable the functioning of the particular software of interest to the ISP user, as well as the continued functionality of the same software. Broadly then, the instantly claimed invention provides, *inter alia*, a system and method for the distribution of free software by an ISP to and for the use of its customers during the period of time in which the user remains a customer of the ISP. Should the relationship between user and ISP end, the present invention ensures that the continued unauthorized use of the software is no longer possible. Furthermore, the presently claimed invention, also, provides a system and method for automatically updating the licensing information required for the use of the provided software upon a users authorized connection with an ISP.

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The License Key (L-key) and the Program Key (P-key)

In the preferred embodiment of the present invention use is made of an L-key and a P-key. An L-key provides the necessary information as to software usage allowability for the software downloaded. The L-key "[i]s referred to when the software is activated or when a specific function of the software is used following activation." (Pg. 14, lines 4-5) Importantly to the present embodiment, an encrypted L-key is generated or updated (re-generated) using a P-key, a user ID, and a representation of time (Time). The user ID, provided for the generation of the L-key is, itself, generated from the IP address assigned to a user upon the user's authorized connection to the ISP via a dialer, wherein a user ID and password are required for authentication. Only a valid customer is provided an authorized connection. Therefore, it is clear that in one embodiment of the present invention the L-key relates to licensing information and is created from various associations, including a P-key, Time, user ID, user IP address, and an established network connection with an authorized customer of the ISP network.

Having now touched upon the L-key, the Program Key or P-key will be discussed. In the presently preferred embodiment, the P-key serves multiple functions for the identification of various attributes associated with particular software programs available for an ISP customer's use (Fig. 9), as well as for use in the generation and updating of the L-key. In general terms, a P-key provides information as to the attributes of a particular software program of interest to a user. The P-key is capable of being transmitted about a

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network and can be stored at various locations, including a predetermined library at the user's terminal referable to by a dialer (Pg. 23, lines 14-15). Various other attributes of the P-key can be better understood by way of a discussion of its use in an embodiment of the present invention.

Overview of an Embodiment of the Method and System of the Present Invention

Figures 4, 5, and 6 provide important flow diagrams for one embodiment of the present invention. In this embodiment, a user connects to an ISP by establishing an authorized connection, which can be achieved using a dialer providing the user's ID and password to an ISP via a connection request. A connection is allowed where the user's information regarding whether the user is a valid customer is authenticated, i.e., a paying customer is provided an authenticated network connection. After a connection is established, an IP address is assigned and transmitted to the user along with a service menu. An L-key is either generated or re-generated (updated) depending on whether programs licensed to the user have already been downloaded to the user's terminal. For example, where the user establishes a first time connection with the ISP there are no programs and no L-keys at the user's terminal to be updated, instead a new L-key is generated. Conversely, where a user has previously connected to the ISP and downloaded programs there would already be an L-key that could then be updated, i.e., replaced with a regenerated L-key. As indicated above, the generation of an L-key is a function of, *inter alia*, the determination whether any P-keys and, therefore, downloaded programs are present at a user's terminal.

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In the situation given above, wherein a user establishes a first time connection with an ISP, a dialer can be used to determine whether P-keys are present at the user's terminal. A user may then be given the opportunity to select programs of interest to be downloaded to the user's terminal for future use. As shown in Figure 5, upon requesting a particular program to be downloaded, an IP address and a P-key are sent to a subscription manager. The IP address is used to determine the particular user's ID. An L-key can then be generated by using the P-key, the user ID and Time. Finally, the P-key, the requested program, and the L-key can be transmitted to the user's terminal, where the program can be used according to the ISP's licensing terms. On the other hand, in the situation above, if after a connection is established between the user's terminal and the network ISP, the dialer determines that a P-key is present at the user's terminal, then an L-key may be simply updated. In the preferred embodiment the presence of a P-key means the user must have a downloaded program and an L-key.

One method of updating an L-key in at least one embodiment of the present invention is represented in Figure 6. First, a user need not select a program of interest, since in such a situation one would already have been previously selected and downloaded. A P-key associated with the previously downloaded program resident on the user's terminal can be transmitted to the ISP server where it is used in conjunction with the user ID (established using the assigned IP address as discussed above) and Time to generate another L-key containing updated licensing information, which thereafter is sent to the user's terminal and replaces the prior L-key thus enabling an updating to occur.

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Upon the activation and use of a downloaded program reference can be made to an appropriate L-key to obtain the licensing information regarding a particular program's valid usage, such that when the program matches a predetermined licensing condition it will no longer function or will only partially function. Thus a useful and novel solution to the distribution of software for use by ISP customers during the period of continued membership with the ISP has been solved.

The Ahmad Reference Summarized

Presently, Claims 1-7 have been rejected under 35 U.S.C. § 103 (a) as obvious over Ahmad in view of art official noticed. As indicated in the Applicant's last reply, as best understood, Ahmad appears to be directed toward a method for monitoring the validity of software that is rented by a user and downloaded from an Internet site. (Col. 2, lines 11-19) The method seems to be accomplished through a process whereby a user downloads three (3) modules: a Check-in/Check-out (CICO) module; a Software Monitor (SM) module; and a program module. The CICO appears to supply relevant licensing information to the program module via the SM. The SM, in turn, appears to enable or disable the program according to the current license, as well as tracking the use of the program when the licensed information is found to allow for the program modules use. A user desiring to rent some particular software module will first access an Internet location where the appropriate contract and payment can be made, afterwards, the modules are downloaded. When the allotted rental time has expired the user can "[r]e-rent the program module for subsequent use. For subsequent rental of the program module by the user, there is no need to download the program module from the rental

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service provider's server, but a new CICO module must be downloaded from the real service provider's server for such subsequent rentals of the program module." (Col. 14, lines 67 - Col. 15, lines 5) In this way the Ahmad invention focuses upon overcoming the problem of monitoring rented software. (Col. 15, lines 6-8)

Patentability Considerations for the Reconsideration of the Rejections of Claims 1-7

Regarding the rejection of the first independent claim of the Applicant's invention, the outstanding Office Action indicates, "Ahmad discloses an information distribution method for transmitting information to an information terminal connected via a network, comprising the steps of:

a user, who uses a network via a network provider under a condition of payment of a connection fee, transmitting a connection request that includes a user ID from an information terminal of said user to said network provider ("logs on to Internet"; column 8, lines 54-57);

downloading a program from a server managed by said network provider, or by an entity that has a tie-up with said network provider (column 8, lines 42-53; column 9, line 45-49);

transmitting, to said information terminal of said user, either a license key that is referred to when said downloaded program is activated or executed and that disables at least a part of the function of said program when said program matches a predetermined license condition, or information with which said license key can be generated ("CICO module") ; (column9, lines 58-62; column 10, lines 21-34);

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again transmitting, at a time subsequent to said immediately preceding step, a connection request that includes said user ID from said information terminal of said user to said network provider; and transmitting, to said information terminal of said user, either a new license key that is referred to when said downloaded program is activated or executed and that disables at least a part of the function of said program when said program matches another predetermined license condition, or information with which said new license key can be generated. (column 14, line 66 - column 15, line 5)" Official notice is "[t]ransmitting a user ID along with a connection request in a Internet network system was well known in the art at the time the invention was made." (Office Action pgs. 3-5).

In addition, Claims 4-7 were also rejected using the rationale of the rejection of Claim 1, above. The Applicant would like to take this opportunity to provide the following remarks in support of reconsideration and withdrawal of the present rejections. First it should be stated, to establish a *prima facie* case of obviousness under 35 U.S.C. 103 there must be: a suggestion or motivation to modify the reference or combine references; a reasonable expectation of success in making the modification or combination; and the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the first element of Claim 1, a "condition of payment of a connection fee" is recited and is not contained in any of the cited prior art. In the event that Examiner would find this recital to be known in the art, it should be noted that it would not have been

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been obvious to combine or modify the prior art with this limitation for the purpose of providing an extensive ISP software licensing scheme as currently claimed.

The third element of Claim 1 includes the transmission of an L-key to a user, which is not met by Ahmad's "CICO." The CICO of Ahmad appears to provide licensing information that can be downloaded to a user's computer; however, the CICO as described in Ahmad is not created in the way the present invention's L-key is created, e.g. using a P-key, user ID (from the user assigned IP address), and Time. Therefore, the element has not been taught or suggested. In addition, Ahmad provides no teaching for the generation of an L-key at the user's terminal, which is also set forth in the third element of Claim 1.

A claim is to be examined using the broadest meaning it can have in light of the specification. The specification clearly describes a myriad of differences between an L-key and Ahmad's CICO so that it is also clear the use of a licensing key in the claims is different than a CICO. Moreover, there is nothing in the references cited or the state of the art that would suggest, if such a thing were possible, to somehow modify Ahmad's CICO to meet the present invention's L-key.

In the fourth element of Claim 1 a subsequent connection is established and an L-key is transmitted to the user's terminal. Ahmad's disclosure of a user's ability to "re-rent the program module..." does not meet the Claim's limitation. (Column 14, line 67) This is because the present invention provides a seamless system and method for the user's continued use of downloaded software dependent upon remaining an ISP customer. This

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is achieved via updating software licensing upon the connection with the ISP. By establishing a connection using an authentication process, checking for P-keys related to programs already having been downloaded, and generating another L-key to update licensing information, a very different and non-obvious invention is presently claimed. Ahmad, in contrast, appears to provide a way in which a program can be re-rented by paying a fee and downloading a new CICO, i.e., a user simply pays for another license for the user of software. Ahmad, therefore, simply fails to teach or suggest to one skilled in the art, the limitation as provided in the forth element of Claim 1.

While "[t]ransmitting a user ID along with a connection request in an Internet network system..." has been officially noticed in Claim 1, the same does not establish *prima facie* obviousness without some reference to the motivation to modify or combine the references to produce the presently claimed invention, an expectation of success in making the combination, as well as actually teaching all the elements of the invention. In this instance all three requirements are lacking. One reason for the significant differences can be found in the different ways in which the inventions allow for monitoring of software in very different situations thus having different concerns. Simply, Ahmad fails to teach the present invention, because it was not intended to solve a problem of an ISP sharing software with its customers, rather Ahmad addresses the problem of monitoring software rentals. This difference in the problems addressed has necessitated very different inventions.

So as not belabor the points above, it is respectfully submitted that the rationale regarding the reconsideration of the rejection of Claim 1 is applicable to the rejections of

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Claims 4-7 as well; therefore, withdrawal of these rejections is likewise requested.

Because Claim 1 is narrower than Claims 2 and 3 it is clear that they should be allowed as well for similar reasons, however, some additional points are worth making at this juncture.

The rejections of Claims 2 and 3 should be withdrawn, because Ahmad and the noticed art fails to teach or suggest all the claim limitations provided in the Claims. The limitations that have not been taught or suggested include, *inter alia*: a connection under a condition of payment; assigning and registering a set consisting of a user ID and a correlated IP address; a dialer determining whether a program key, uniquely identifying a program type at said network provider is present at said information terminal; a file server connection request; generating an L-key based on specific downloaded program information, the user ID specified for an assigned IP address and licensing conditions of the program; disconnecting and reconnecting; checking again for programs; transmitting program information from a user's terminal to the ISP; generating a new or updated L-key; and transmitting the L-key to the user. As indicated in the overview, Ahmad and the present invention are different inventions comprised of different elements; therefore, the combination required to make the present invention is, simply, not possible and, thus, the invention as claimed is not obvious.

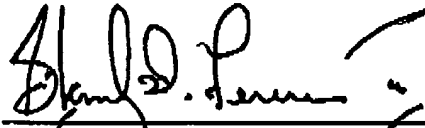
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In view of the foregoing, it is respectfully submitted that Claims 1-7 are fully distinguishable over the applied art and immediately allowable. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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